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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,030	11/04/2003	Thomas L. Kelly	KES-0004	6735
23413	7590	10/21/2008		
CANTOR COLBURN, LLP 20 Church Street 22nd Floor Hartford, CT 06103			EXAMINER A, PHI DIEU TRAN	
			ART UNIT 3633	PAPER NUMBER
			NOTIFICATION DATE 10/21/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/702,030	<b>Applicant(s)</b> KELLY, THOMAS L.	
	<b>Examiner</b> PHI D. A	<b>Art Unit</b> 3633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/30/08 has been entered.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The limitation of “ a first piece....said top of said fastener only, such that said first piece is positioned....an entirety of no other roofing component” is not enabled by the specification. The disclosure clearly shows a component (the washer) being covered by the energy absorbing material.

3. Claims 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 10 “ said at least one piece” is indefinite as it broadens the scope of the independent claim.

Claim 11 last three " first layer and a washer of the fastener" is indefinite as the disclosure does not disclose the washer to be on top of the fastener. As such, the first layer has to cover both the fastener and the washer.

Claim 13 line 3 “ directly over and underlying fastener” is confusing.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Resan (4841706).

Resan shows a roof system with reduced hail/fastener impact damage characteristics comprising: a roof substrate having one or more layers of material (30); at least one top of at least one fastener(28) exposed at a top surface of said substrate; a roof waterproofing membrane (38) positioned over said at least one fastener; and at least one-two individual piece of energy absorbing material (14, 40) positioned atop all forgoing elements and any-said waterproofing membrane to discretely cover said tops of each individual fastener of said at least one fasteners, said at least two pieces including a first piece that is positioned and dimensioned to cover said top of said fastener only, such that said first piece is positioned and dimensioned to said top of said fastener so as to cover an entirety of no other roofing component, and said at least two pieces including a second piece that is affixed to a relative top of said first piece.

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***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benoit (4437283) in view of Simmons et al (4885887).

Benoit (figures 1-5) shows a method for reducing damage in a roof membrane of a roof substrate caused by hail/fastener impact comprising: locating fasteners(42) in a roof construction such that a top of said fastener is exposed at a top surface of the roof substrate (82, 14, 16), positioning at least two individual pieces of energy absorbing material(figure 5, parts 98, 100) to discretely cover each individual fastener of said fasteners whereby said fastener is completely covered by both of said at least two pieces, said at least two pieces including a first piece (98) that is positioned and dimensioned to cover said top of said fastener only, such that said first piece is positioned and dimensioned to cover an entirety of no other roofing component; and affixing said first piece to said top of fastener; affixing a second piece of said at least two individual pieces of energy absorbing material to a relative top of said first piece, wherein said affixing is by adhering, wherein said adhering is by a self stick adhesive(the part of 98 which sticks) applied to said energy absorbing material, a roof substrate having one or more layers of material, the one or more layer of roof material including insulation, wherein said energy absorbing material is cover tape (98), said cover tape is self-adhesive tape, wherein said at least one piece of energy absorbing material is two layers of energy absorbing material,

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wherein said two layers comprise a first layer covering a fastener and a second layer covering the first layer and a washer (82) of the fastener, wherein said energy absorbing material is installed on top of the roof membrane in an area directly over and underlying fastener.

Benoit does not disclose the step of positioning a roof waterproofing membrane atop all forgoing elements.

Simmons et al discloses the step of positioning a roof waterproofing membrane atop all forgoing elements.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Benoit's teaching to show the step of positioning a roof waterproofing membrane atop all forgoing elements as taught by Simmons et al in order to provide an extra layer of water proofing material to insulate the roof against leaking.

3. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benoit (4437283) in view of Simmons et al (4885887) as applied to claim 4 or 6 above and further in view of Alexander (5204148).

Benoit as modified shows all the claimed limitations except for said energy absorbing material is a self-sticking cover tape composed of cured ethylene propylene diene monomer (EPDM) membrane with a butyl gum rubber bottom, wherein said cover tape is ethylene propylene diene monomer

Alexander (lines 12-26, column 5) discloses a tape composed of cured ethylene propylene diene monomer (EPDM) membrane with a butyl gum rubber bottom, wherein said cover tape is ethylene propylene diene monomer

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It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Benoit's modified teaching to show the a tape composed of cured ethylene propylene diene monomer (EPDM) membrane with a butyl gum rubber bottom, wherein said cover tape is ethylene propylene diene monomer as taught by Alexander in order to provide for quick, effective sealing of the fasteners.

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different roof fastening methods.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 571-272-6864. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Phi D A/  
Primary Examiner, Art Unit 3633

Phi Dieu Tran A

10/13/08